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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,116	11/25/2003	Atsushi Koide	AK-N-432XX	4859
207	7590	12/01/2006	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			AHMED, SHEEBA	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,116

Applicant(s)

KOIDE ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/06 and 7/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendments to claims 1 and 2 have been entered in the above-identified application. Claim 3 has been cancelled. **Claims 1 and 2 are pending.**

Specification

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

Page 2, lines 13-16 state "As a result, there is a problem that adoption of the above-mentioned technique to a product with a complex shape, even in the usage as a magnetic wave shield material (shield material for magnetic wave?)".

Page 4, lines 9-18 state that "Even if the above-mentioned conductive resin plate is in the state insulated by the surface resin, an end of a conductive part breaks through the insulating skin 1 and reaches the core 2 when the part sticks into the resin plate, therefore, the part becomes to be electrically connected with the conductive core 2. Such conductive resin plate can be used as an electromagnetic wave shield material having an insulating skin as it is, and can also be used as a base material for a laminated connector. The conductive resin plate is also applicable to many other uses than those". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 2 have been amended to recite that the resin insulating skin of the conductive resin molded product contains a non-conductive resin and a carbon nano material. However, Page 2 lines 30-35 to Page 3, lines 1-20 state that "the conductive resin molded product for the above- mentioned purpose according to the present invention comprises a resin insulating skin and a conductive core covered with said skin and, is composed of a composite containing a non- conductive resin and a carbon nano material. The resin insulating skin is obtainable from molding said composite by controlling an amount of the carbon nano material to be composited with the non- conductive resin". Furthermore, Page 3, lines 30-35 to Page 4, lines 1-10 state that "Fig. 1 shows an enlarged cross sectional view of a part of a conductive resin plate mentioned as an example of the present invention, and the reference numeral 1 is an insulating resin skin, the reference numeral 2 a conductive core coated with the insulating skin 1. The conductive resin plate is obtained by injection molding a

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composite conductive material with which a carbon nano material is blended. It is a flat plate with a thickness of 1.5 to 3.0 mm and **the core 2 having conductivity brought by the carbon nano material inside of it**".

These paragraphs of the Specification indicate that the conductive core of the conductive resin molded product is formed from the resin and the carbon- nano material and not the resin insulating skin. In addition, Page 2, lines 27-30 also state that the carbon nano material is conductive and hence this raises the issue of how does one obtain an insulating resin skin with the use of a conductive carbon nano material. Appropriate correction or clarification is required.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.



Sheeba Ahmed
Art Unit 1773
November 24, 2006